

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF SKOLD

Appeal 2008-2366
Application 09/381,828
Technology Center 1700

Decided: August 26, 2008

Before BRADLEY R. GARRIS, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

ORDER PURSUANT TO 37 C.F.R. § 41.50(d)

According to 37 C.F.R. § 41.50(d)(2007):

The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such an order. Failure to timely comply with the order may result in the *sua sponte* dismissal of the appeal.

Pursuant to § 41.50(d), we order Appellant to additionally brief the issue of whether Appellant's rebuttal of the § 103 rejections on appeal includes declaration evidence under 37 C.F.R. § 1.132. This additional briefing is required in order to eliminate inconsistencies in the briefs concerning this issue. Specifically, in APPENDIX B (i.e., the Evidence Appendix), Appellant states that "[n]o evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Examiner is being submitted" (App. Br. 65). However, this statement is not consistent with arguments in the Briefs which refer to and seemingly rely upon certain § 1.132 Declarations of record (App. Br. 16-17, 51 et seq.; Reply Br. 11 et seq.). These inconsistencies are exacerbated by the fact that the Evidence Appendix of the Appeal Brief does not include copies of the Declarations referred to in the Brief Arguments.

Therefore, Appellant must respond to this Order by filing a Supplemental Brief which eliminates the above-discussed inconsistencies in one of two ways. First, Appellant may affirmatively state in the Supplemental Brief that no § 1.132 Declarations are relied upon in rebuttal of the § 103 rejections on appeal and that the arguments in the Appeal and Reply Briefs currently of record should be treated as unsupported by such Declaration evidence. Alternatively, Appellant may clarify in the Supplemental Brief that the § 1.132 Declarations referred to in the Brief arguments are being relied upon and submitted as rebuttal evidence in which case the Supplemental Brief must include a replacement Evidence Appendix in compliance with 37 CFR § 41.37(c)(1)(ix). In this latter regard, we emphasize that § 41.37(c)(1)(ix) requires an Evidence Appendix to contain copies of any evidence submitted pursuant to § 1.132 which has been

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entered by the Examiner and relied upon by the Appellant in the appeal along with a statement setting forth where in the record the evidence was entered by the Examiner.

Appellant is given a non-extendable time period of ONE MONTH from the mailing date of this ORDER within which to comply with this ORDER.

**FAILURE TO RESPOND AND COMPLY TO THIS ORDER
WITHIN THE ONE MONTH TIME FRAME MAY RESULT IN SUA
SPONTE DISMISSAL OF THIS APPEAL.**

37 C.F.R. § 41.50(d)(2006).

No time period for taking any subsequent action in connection with this appeal may be extended. 37 C.F.R. § 1.136(a)(1)(iv).

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